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| 10/038,494 | 01/03/2002 | Amir Najmi | 166.001A | 5520 |
| 9651 | 7590 | 02/18/2005 | EXAMINER | |
| ELLIOT B. ARONSON 5001 HARBORD DRIVE OAKLAND, CA 94618 | | | HIRL, JOSEPH P | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2121 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,494

Applicant(s)

NAJMI ET AL.

Examiner

Joseph P. Hirl

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-26 are pending in this application.

Abstract Objection

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The abstract word count is 335 words.

This objection must be corrected.

Claim Objections

3. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 5 fully covers the

identified equation over the index i which always has a beginning point and an end point ... end alternatives. Consequently claim 5 runs only over the end alternatives ... because that is what the index i defines.

This objection must be corrected.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 5, 10 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification @ p 22 lines 1-7 teaches that Lambda and Gamma are variables, not constants, related to market segment and to maturity of the model, respectively.

6. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification @ p 27 line 10 teaches b_i is a user-specific weighting factor with no indication that such weighting factor is estimated by an empirical Bayes formulation.

7. Claims 8, 9, 16 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification @ p 24 lines 11-16 teaches that the Empirical Bayes estimator is not required by this invention albeit such approach might be useful. Since the applicant has specifically stated that Empirical Bayes is not part of the invention and that further, the statement is made @ specification, p 24, lines 14 and 15, that "not giving the detail algorithm of an Empirical Bayes estimator", such an estimator is simply not enabled for this invention.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-4, 7-9, 12-23, 25 and 26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 09/923,916. Although the conflicting claims are not identical, they are not patentably distinct from each other because objective models can be statistical models.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. While using a trivial example, the subject claims can be implemented using a pencil and paper. The use of the term "computerized" in the related independent claims can overcome this rejection.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-4, 7-9, 12-23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Lang et al (U. S. Patent 5,867,799, referred to as **Lang**).

Claim 1

Lang anticipates providing an objective model for said plurality of alternative choices, said objective model reflecting at least user-specific weighting factors for said alternative choices (**Lang**, c 4, l 43-60; Examiner's Note (EN): para 15 below applies; an

informon is an alternative choice; objective model is represented by the assembly of the various functions; weights are part of the encoded profiles); applying said objective model to a first ordered selection of choices to derive a recommended selection of choices of optimized order, said optimized order being determined by said objective model (**Lang**, c 4, l 43-60; EN: optimized ordering is achieved by adaptively filtering the raw informons to a particular profile); and maintaining said recommended selection of choices for presentation to said user through said electronic device substantially in said optimized order (**Lang**, c 4, l 43-60; c 1, l 9-12).

Claims 2, 14

Lang anticipates objective model further reflects third-party weighting factors (**Lang**, c 4, l 43-60; EN: third party weighting factors are represented by the community).

Claim 3

Lang anticipates plurality of alternative choices is provided by a service operator and said method further comprises the step of including in said objective model a weighting factor reflecting preferences of said service operator in presenting alternatives to said user (**Lang**, c 4, l 43-60; c 5, l 1-13; EN: service operator is the computer network; weighting factors are in the prefiltering profile).

Claim 4

Lang anticipates at least one of said alternative choices is provided by a third-party advertiser and said method further comprises the step of including in said objective model a weighting factor reflecting preferences of said third-party advertiser in

presenting alternatives to said user (**Lang**, c 5, l 1-13; EN: adaptive broker profile provides alternative (advertise) informons).

Claims 7, 13, 23, 25

Lang anticipates providing an objective model for said plurality of alternative choices, said objective model including a plurality of user-specific weighting factors (**Lang**, c 4, l 43-60); providing a statistical model for setting the values of at least some of said user-specific weighting factors and applying said statistical model for setting said values (**Lang**, c 4, l 43-60; EN: para 15 below applies; the profiles represent statistical models); applying said objective model with said values set by said statistical model to a first ordered selection of choices to derive a recommended selection of choices of optimized order, said optimized order being determined by said objective model (**Lang**, c 4, l 43-60; EN: the optimized order is represented by process of profile application); and maintaining said recommended selection of choices for presentation to said user through said electronic device substantially in said optimized order (**Lang**, c 4, l 43-60; c 1, l 9-12).

Claim 12

Lang anticipates providing an objective model for said plurality of alternative Choices (**Lang**, c 4, l 43-60); applying said objective model to a first ordered selection of choices to derive a recommended selection of choices of optimized order, said optimized order being determined by said objective model (**Lang**, c 4, l 43-60); presenting said recommended selection of choices to said user substantially in said optimized order for further selection of an end alternative by said user (**Lang**, c 4, l 43-

60; EN: method is interactive, providing for user input); when said end alternative calls for entry of data by said user, applying said objective model to derive a recommended selection of prefill data objects (**Lang**, c 5, l 14-38; such are proposed informons); and presenting said recommended selection of prefill data objects to said user (**Lang**, c 5, l 31-32).

Claim 15

Lang anticipates providing a statistical model for setting the values of at least some of said user-specific weighting factors and applying said statistical model for setting said values (**Lang**, c 4, l 43-60).

Claim 17

Lang anticipates defining a plurality of characteristic groups of users (**Lang**, c 4, l 43-60; EN: user is a member client community with appropriate profiles); for a given user, transforming said initial ordered data structure into a reduced data structure associated with at least one of said characteristic groups (**Lang**, c 4, l 43-60; EN: such is the method of the dynamic informon characterization); applying an objective model to said reduced data structure, said objective model including parameters particularized to said given user, to derive a recommended data structure for said given user (**Lang**, c 4, l 43-60; EN: such is the summary of invention model by Lang).

Claim 18

Lang anticipates applying a content filter to at least one of said initial data structure, said reduced data structure and said recommended data structure, thereby to

provide a refined recommended data structure (**Lang**, c 4, l 43-60; EN: adaptively filtering applies).

Claim 19

Lang anticipates said content filter is applied to one of said initial data structure and said reduced data structure before said objective model is applied (**Lang**, c 5, l 1-13; EN: prefiltering applies).

Claim 20

Lang anticipates said content filter is applied after said objective model is applied (**Lang**, c 4, l 43-60; EN: adaptively filtering to dynamic informon characterization applies).

Claim 21

Lang anticipates applying a content filter to said initial ordered data structure, to define a reduced data structure (**Lang**, c 4, l 43-60; EN: adaptively filtering applies); and applying an objective model to said reduced data structure, said objective model including parameters particularized to a given user, to derive a recommended data structure for said given user (**Lang**, c 4, l 43-60).

Claim 22

Lang anticipates determining a characteristic type of data appropriate for filling said request for data entry (**Lang**, c 4, l 43-60); associating a probability of relevance to a plurality of other instances of data of said characteristic type associated with said user (**Lang**, c 11, l 8-17); and ordering said plurality of other instances substantially in

accordance with said probability of relevance for presentation to said user (**Lang**, c 11, l 8-17).

Examination Considerations

13. The claims and only the claims form the metes and bounds of the invention.

“Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)” (MPEP p 2100-8, c 2, l 45-48; p 2100-9, c 1, l 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

14. Examiner's Notes are provided to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and unless otherwise stated, the Examiner's Notes are not prior art but a link to prior art that one of ordinary skill in the art would find inherently appropriate.

15. Examiner's Opinion: Paras 13. and 14. apply. Applicant is advised to fully appreciate that the Examiner has full latitude to interpret each claim in the broadest reasonable sense. Further, limitations appearing in the specification but not recited in the claim are not read into the claim.

Conclusion

16. The prior art of record and not relied upon is considered pertinent to applicant's disclosure.

- Coleman, U.S. Pub 2004/0024656
- Brandenburg et al, U.S. Patent 6,834,195
- Brandenburg et al, U.S. Pub 2003/0063072
- Parulski, U.S. 6539177

17. Claims 1-26 are rejected.

Correspondence Information

Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is (571) 272-3685. The Examiner can be reached on Monday – Thursday from

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6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anthony Knight can be reached at (571) 272-3687.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,

Washington, D. C. 20231;

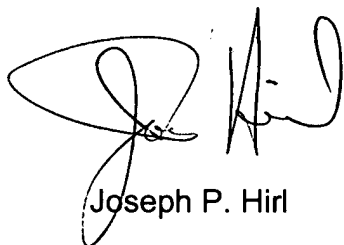
or faxed to:

(703) 872-9306 (for formal communications intended for entry);

or faxed to:

(571) 273-3685 (for informal or draft communications with notation of

"Proposed" or "Draft" for the desk of the Examiner).

A handwritten signature in black ink, appearing to read 'J. P. Hirl', with a large, stylized loop on the left side.

Joseph P. Hirl

February 15, 2005